

REMARKS

I. Status of Claims

Claims 1-69 are pending in this application. Claims 4-17, 19-24, 26, 27, 29-34, 40-42, and 59-69 were withdrawn from consideration as directed to non-elected invention/species. No amendments are made in this Reply.

II. Claim Rejections under 35 U.S.C. § 103

A. Sweger in view of Matsumoto and Uchiyama

The Office maintained and finalized the rejection of claims 1-3, 18, 25, 28, 38, 39, and 43-58 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,482,704 to Sweger et al. ("Sweger") in view of U.S. Patent No. 6,010,689 to Matsumoto et al. ("Matsumoto") and U.S. Patent No. 5,876,705 to Uchiyama et al. ("Uchiyama"). Office Action at page 2.

In response to Applicants' argument that the combination of cited references cannot be relied upon simply because the references disclose what is "normally used," the Office continues to assert there is a motivation to combine because hair conditioners and surfactants are well-known essential ingredients and are known to be used in hair compositions similar to those claimed. *Id.* at page 5. These broad conclusory statements regarding the teachings of multiple references alone are not sufficient to amount to actual evidence that is "clear and particular" under an obviousness inquiry. See *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q. 2d 1614, 1617 (Fed. Cir. 1999) (explaining that the motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or from the

nature of the problem to be solved but must still be supported by actual evidence that is “clear and particular”). As such, Applicants respectfully disagree for the reasons of record and for the following additional reasons.

In *In re Lee*, the Federal Circuit reinforced numerous decisions requiring that “the factual inquiry whether to combine references must be thorough and searching.” 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002). In particular, the court emphasized the need for specificity. *Id.* As stated in *Dembiczak*, “our case law makes clear that the best defense against the subtle but powerful attraction of hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” 175 F.3d at 999, 50 U.S.P.Q.2d at 1617.

Instead, the Office continues to attempt to rationalize a motivation to combine the cited references based on what is “normally used” in hair compositions. Office Action at page 3, lines 1-3, 14-16. Mere identification of claim elements in separate prior art references, however, does not, in itself, preclude patentability. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998) (stating that “rejecting patents solely by finding prior art corollaries for the claimed invention would permit the examiner to use the claimed invention itself as a blueprint. . . . Such an approach would be an ‘illogical and inappropriate process by which to determine patentability.’”).

For instance, the Office asserts that

hair conditioners and surfactants are well-known essential ingredients normally used for hair compositions (knowledge generally available to one of ordinary skill in the art), and the cited references teach the particular hair conditioners and

surfactants are known to be used in the hair composition similar [to] those herein claimed.

Office Action at page 5, lines 16-20. These assertions do not explain with "clear and particular" evidence the reasons one of ordinary skill in the art would have been motivated to select the cited references and combine them to render the claimed invention obvious.

Furthermore, the Office relies on Sweger's teachings of amino-multicarboxylate modified starch. Office Action at page 2. Because Sweger does not teach conditioning agents or anionic surfactants, the Office relies on Matsumoto and Uchiyama. *Id.* at page 3. In particular, Matsumoto is relied upon for teaching behenyltrimethylammonium (conditioning agent) and alkyl ether sulfate (anionic surfactant). *Id.* The Office relies upon Uchiyama to teach "a conditioning shampoo compositions may comprise anionic surfactants, conditioning agent, . . . and thickener." *Id.* Irrespective of whether this is a true reading of Matsumoto or Uchiyama, the Examiner is picking and choosing from various references in an attempt to achieve the claimed invention. However, "[i]t is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Wesslau*, 353 F.2d 238, 241, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965).

For example, Matsumoto is directed to hair treatment composition containing particular types of functional silicone that generate certain conditioning benefits.

Matsumoto at Col. 1, ll. 26-30. Matsumoto states that “[h]air treatment compositions according to the[ir] inventions may suitably take the form of shampoos, conditioners, sprays, gels, mousses or lotions.” *Id.* at Col. 2, ll. 9-12. Matsumoto then goes on to provide ingredients for each of the various forms. *Id.* at Col. 2, line 13-Col. 8, line 22. It is within the different forms and their disclosed ingredients that the Office picks and chooses among the various ingredients. Under “Shampoo Compositions,” the Office finds the disclosure of anionic surfactants. *Id.* at Col. 2, line 13. What the Office fails to recognize is that Matsumoto lists not several or even preferred anionic surfactants but numerous possibilities of anionic surfactants. Indeed, this reference teaches more than anionic surfactants, but instead broadly teaches that “cleaning surfactant[s] may be suitably selected from anionic, nonionic, amphoteric and zwitterionic surfactants and mixtures thereof.” *Id.* at Col. 2, ll. 20-22. It is later in Matsumoto’s disclosure that the Office picks the behenyltrimethyl ammonium chloride out of a listing of hair conditioners under the broad form of “Conditioners.” *Id.* at Col. 5, line 28-Col. 6, line 43. Although all the references are drawn to “cosmetic” compositions, they do not provide the “clear and particular” evidence supporting the combination of references required under a Section 103 inquiry. *Dembicazk*, 175 F.3d at 999, 50 U.S.P.Q.2d at 1617.

For at least these reasons, the Office fails to establish a *prima facie* case of obviousness and thus, Applicants respectfully request the withdrawal of this rejection.

B. Janchipraponvej in view of Sweger and Martino and in further view of Uchiyama

Further, the Office maintained and finalized the rejection of claims 1-3, 18, 25, 28, 38, 39, and 43-58 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 4,954,335 to Janchipraponvej (“Janchipraponvej”) in view of Sweger and U.S. Patent No. 6,210,689 to Martino et al. (“Martino”) and in further view of Uchiyama. Office Action at page 3. In response to Applicants’ arguments, the Office maintains that the motivation to combine the cited references is in the references themselves and in the knowledge generally available to one of ordinary skill in the art. *Id.* at page 7. Applicants respectfully disagree for the reasons of record and for the following additional reasons.

The Office’s statement that “the teaching, suggestion and motivation are provide both in the cited references and in the knowledge generally available to one of ordinary skill in the art” merely regurgitates the standard without support by objective evidence. See Office Action at page 7, II. 4-11. Moreover, the mere identification of the teachings in each reference does not itself preclude patentability. See *Rouffet*, 149 F.3d at 1357, 47 U.S.P.Q.2d at 1458.

For instance, the Office asserts that it was obvious to modify Janchipraponvej’s composition with the amphoteric starches of Sweger and anionic surfactants of Martino “to benefit from the improved results of the amphoteric starches with regard to viscosity and thickening as taught by Sweger.” Office Action at page 4, line 21-page 5, line 3. These conclusory statements fail to provide any objective evidence as to why one of ordinary skill in the art would have been motivated to select the references and to

combine them to render the claimed invention obvious. *Rouffet*, 149 F.3d at 1359, 47 U.S.P.Q.2d at 1493.

Furthermore, combining the teachings of Janchipraponvej with the teachings of Sweger by substituting CEPA starch for polyacrylic acid derivatives in the compositions of Janchipraponvej would render those compositions unsatisfactory for their intended purpose. Janchipraponvej teaches that his compositions are “clear-hair treating” compositions. Janchipraponvej at Col. 1, II. 7-8. Janchipraponvej emphasizes that the compositions of the invention must be clear and used this as a basis to distinguish the invention disclosed therein over several pieces of prior art, including Nachtigal, Bolich et al. and a Japanese reference. *Id.* at Col. 4, II. 1-55. The reference teaches that obtaining such clear compositions requires a delicate balance of five essential ingredients. *Id.* at Col. 15, II. 38-46, Col. 20, II. 49-54. In addition, among the optional additives that can be incorporated are thickeners, such as polyacrylic acid derivatives. *Id.* at Col. 16, II. 9-15. No mention, however, is made of modified starches, such as CEPA-starch taught in Sweger, for use as thickeners in the disclosed compositions.

In order for the Examiner’s modifications to be appropriate, one of ordinary skill in the art would need to conclude, *inter alia*: (1) that an optional additive needs to be included with the composition; (2) that the additive should be a thickener; (3) that the thickener should be polyacrylic acid derivatives; (4) that the polyacrylic acid derivatives are not sufficient thickeners; and (5) that CEPA is a better thickener than polyacrylic acid in this system. The selection of CEPA-starch as the optional additive thickener, however, flies in the face of the teachings of Janchipraponvej at Col. 15, II. 47-54 and

would adversely affect the clarity of the composition. Where the “proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” M.P.E.P. § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)).

The disclosure of Sweger does not remedy the deficiencies in Janchipraponvej. Sweger is directed to “cosmetic compositions which contain amino-monicarboxylate starch derivatives.” Sweger at Col. 1, ll. 34-35. Nowhere in Sweger is there any teaching or suggestion that its disclosed, modified starch compositions would be desirable additives to the compositions of Janchipraponvej. Indeed, nothing but Applicants’ disclosure provides such a suggestion.

Moreover, the Office asserts that Applicants’ argue against the references individually but that one cannot show nonobviousness by attacking references individually where rejections are based on a combination of references. Office Action at page 7, lines 12-15. Applicants disagree for at least the reason that the primary reference, Janchipraponvej, teaches away from Martino’s disclosure. See Reply filed May 21, 2004 at pages 6, 8-10; see also, M.P.E.P. § 2145. The Federal Circuit has repeatedly recognized that proceeding contrary to accepted wisdom in the art presents “strong evidence of unobviousness.” *In re Hodges*, 783 F.2d 1038, 1041, 228 U.S.P.Q. 685, 687 (Fed. Cir. 1986); *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1552, 220 U.S.P.Q. 303, 312 (Fed. Cir. 1983). For this reason alone, the rejection is improper and should be removed.

With regard to the Rule 132 Declaration, the Office contends that “one of ordinary skill in the art would not have expected that CEPA [and] carbomer [to] have identical properties, including solubility. Therefore, the detailed procedure for making CEPA solution would not be the same as those for carbomer.” Office Action at page 6, II. 15-17. As stated, Janchipraponvej expressly teaches that other common cosmetic components may be incorporated with the composition but they must not adversely affect the basic properties of the composition, including the clarity of the composition. Janchipraponvej at Col. 15, II. 47-54. Based on the Office’s contention that CEPA does not have identical solubility as carbomer, one would objectively conclude that it would not have been obvious to incorporate CEPA into Janchipraponvej’s composition. It is a well-established tenant of patent law that a *prima facie* rejection of obviousness is based on the presumption that similar compositions will have similar properties. As noted by the Examiner and shown in the Declaration under Rule 132, this cannot be the case in the present rejection. In other words, solubility differences, would arguably lead to its absence in the Janchipraponvej composition because “the basic properties of the hair-treating composition, such as clarity of the composition . . .” would be affected by an ingredient not going into solution.

In addition, the Office continues to misplace its reliance on *In re Michaleck*, 74 U.S.P.Q. 107 (C.C.P.A. 1974), with regard to the Declaration of Mme. MAHE. Office Action at page 6, line 9-page 7, line 3. In *Michaleck*, the court addressed what weight should be afforded to an affidavit submitted to *contradict* a teaching in a patent. 74 U.S.P.Q. 107. Mme. MAHE’s declaration *does not* contradict Janchipraponvej’s

composition but instead confirms that Janchipraponvej's intended clear composition cannot be achieved using the Office's rationale. Thus, the Office's rationale, which is based on the position that one would look to modify Janchipraponvej's composition with CEPA-modified starch, as discussed in Sweger, is fundamentally flawed since this combination would destroy the intended use of Janchipraponvej's composition. See M.P.E.P. § 2145(X)(D). As such, the cited combination of references fail to establish a *prima facie* case of obviousness and thus, Applicants respectfully request the withdrawal of this rejection.

III. Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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